



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,838	10/03/2008	Niels Ebbe Jacobsen	P3593US00	8747
36671 7590 03/11/2010 DITTHAVONG MORI & STEINER, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER NGUYEN, DAVID Q				
ART UNIT 2617		PAPER NUMBER		
NOTIFICATION DATE 03/11/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

### Office Action Summary

**Application No.**

10/583,838

**Applicant(s)**

JACOBSEN ET AL.

**Examiner**

DAVID Q. NGUYEN

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-7, 9-12, 14-17, 19-20, 24-25, 28-30, 34-35 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis (US 2003/0083046 A1) in view of Goto et al. (US 2002/0160824 A1).

Regarding claim 1, Mathis discloses a communication system comprising: a server having a service element for providing the service (see par. 0019, the server 112 provides a current presence status to each client device, online status or offline status) and a data store for storing the identities of users of the communication system that are registered to the service (see par. 0015 and par. 0019, the contact lists are stored in a memory of the server 112); a user terminal has a data store arranged for storing a plurality of user identities forming a first set of users (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention a user terminal that is capable of initiating verification of the registration of one or more users of the communication system to the service by transmitting to the server one or more messages indicating the identities of the said one or more users; wherein: the, and the user terminal has a user interface arranged to present to a user of the terminal a single command option in response to selection of which the user terminal automatically transmits to the server one or more messages indicating the user identities of the first set of users for verification of

which users of the first set are registered to the service. Goto et al. teach a user terminal that is capable of initiating verification of the registration of one or more users of the communication system to the service by transmitting to the server one or more messages indicating the identities of the said one or more users; wherein: the, and the user terminal has a user interface arranged to present to a user of the terminal a single command option in response to selection of which the user terminal automatically transmits to the server one or more messages indicating the user identities of the first set of users for verification of which users of the first set are registered to the service (see par. 0098; item 'Buddy search' is selected by the player from the menu screen 430. When the activity item 'Buddy search' is transmitted from the cellular telephone 2 to the game server 1, the data for the buddy search screen is read out from the event memory 150 by the buddy search processor 108 is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 17, Mathis teaches a method for checking which users of a communications network are registered to a service of the network, the method comprising: storing the identities of the users of the communication network that are registered to the service in a server (see par. 0015 and par. 0019, the contact lists are stored in a memory of the server 112); storing a plurality of user identities of the communications network in a user terminal as a first set of users (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention presenting a single command option via a user interface to a user of the user terminal; in response to the selection of the command option, automatically transmitting one or

more messages indicating the user identities of the first set of users to the server; and verifying by means of the server which users of the first set are registered to the service. Goto et al. teach presenting a single command option via a user interface to a user of the user terminal (see par. 0098; the activity item "Buddy search" is selected); in response to the selection of the command option, automatically transmitting one or more messages indicating the user identities of the first set of users to the server (see par. 0098; the "Buddy search" is transmitted to the server 1); and verifying by means of the server which users of the first set are registered to the service (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 19, Mathis teaches a user terminal capable of operation by a user for registering to a server of a communication network, the user terminal comprising: a data store for storing a plurality of identities of other users of the network (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention a user interface arranged to present to the user of the user terminal a single command option, and a translation element for cooperating with the user interface such that upon selection of the single command by the user, the translation element generates one or more messages which are automatically transmitted from the user terminal to the server for verifying which of the other users are registered to the server. Goto et al. teach a user interface arranged to present to the user of the user terminal a single command option (see par. 0098; the activity item "Buddy search" is selected), and a translation element for cooperating with the user interface such that upon selection of the single command

by the user, the translation element generates one or more messages which are automatically transmitted from the user terminal to the server (see par. 0098; the “Buddy search” is transmitted to the server 1) for verifying which of the other users are registered to the server (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 24, Mathis teaches a method for checking registration status of users, the method comprising: storing a plurality of user identities in a user terminal as a first set of users (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention presenting a single command option via a user interface to a user of the user terminal; in response to selection of the command option, automatically transmitting one or more messages indicating the user identities of the first set of users to a server where identities of users that are registered to the service are stored for verification of the registration status of the users. Goto et al. teach presenting a single command option via a user interface to a user of the user terminal (see par. 0098; the activity item “Buddy search” is selected); in response to selection of the command option, automatically transmitting one or more messages indicating the user identities of the first set of users to a server where identities of users that are registered to the service are stored for verification of the registration status of the users (see par. 0098; the “Buddy search” is transmitted to the server 1 and the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that

user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 28, Mathis teaches a method for providing users with information of service registration status of other users of a communications network, the method comprising: storing identities of users of the communication network that are registered to a service in a server (see par. 0015 and par. 0019, the contact lists are stored in a memory of the server 112); user identities of the first set of users as stored in the user terminal (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention receiving from a user terminal one or more messages indicating user identities of a first set of users, wherein the one or more messages are generated based on user identities of the first set of users as stored in the user terminal and automatically sent in response to selection of a single command option; and verifying which users of the first set are registered to the service. Goto et al. teach receiving from a user terminal one or more messages indicating user identities of a first set of users (see par. 0098; the activity item "Buddy search" is selected), wherein the one or more messages are generated based on user identities of the first set of users as stored in the user terminal and automatically sent in response to selection of a single command option (see par. 0098; the "Buddy search" is transmitted to the server 1 and the data for the buddy search is transmitted to and displayed on the cellular phone 2); and verifying which users of the first set are registered to the service (see par. 0098; the "Buddy search" is transmitted to the server 1 and the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 34, Mathis teaches a server for providing users with a service via a communications network, comprising: a service element for providing the service (see par. 0019, the server 112 provides a current presence status to each client device, online status or offline status); a data store for storing identities of users of the communication system that are registered to the service (see par. 0015 and par. 0019, the contact lists are stored in a memory of the server 112). Mathis does not teach a controller configured to process one or more messages received from a user terminal and indicative of user identities of a first set of users, wherein the one or more messages are generated based on user identities of the first set of users as stored in the user terminal and automatically sent in response to selection of a single command option, and to verify which users of the first set are registered to the service. Goto et al. teach a controller configured to process one or more messages received from a user terminal and indicative of user identities of a first set of users, wherein the one or more messages are generated based on user identities of the first set of users as stored in the user terminal and automatically sent in response to selection of a single command option, and to verify which users of the first set are registered to the service(see par. 0098; the “Buddy search” is transmitted to the server 1 and the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 35, Mathis teaches a program product, comprising machine readable program code for causing performing of the following steps: storing a plurality of user identities in a user terminal as a first set of users (see par. 0018, contact list is stored in the memory of client device). Mathis does not mention presenting a single command option via a user interface to a user of the user terminal; and in response to selection of the command option, automatically transmitting one or more messages indicating the user identities of the first set of users to a server where identities of users that are registered to the service are stored for verification of the registration status of the users. Goto et al. teach presenting a single command option via a user interface to a user of the user terminal (see par. 0098; the activity item “Buddy search” is selected); and in response to selection of the command option, automatically transmitting one or more messages indicating the user identities of the first set of users to a server (see par. 0098; the “Buddy search” is transmitted to the server 1) where identities of users that are registered to the service are stored for verification of the registration status of the users (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claim 37, Mathis teaches a program product, comprising machine readable program code for causing performing of the following steps: storing identities of users of the communication network that are registered to a service in a server (see par. 0015 and par. 0019, the contact lists are stored in a memory of the server 112) and user identities of the first set of users as stored in the user terminal (see par. 0018, contact list is stored in the memory of client

device). Mathis does not mention receiving from a user terminal one or more messages indicating user identities of a first set of users, wherein the one or more messages are generated based on user identities of the first set of users and automatically sent in response to selection of a single command option; and verifying which users of the first set are registered to the service. Goto et al. teach receiving from a user terminal one or more messages indicating user identities of a first set of users (see par. 0098; the “Buddy search” is transmitted to the server 1), wherein the one or more messages are generated based on user identities of the first set of users and automatically sent in response to selection of a single command option (see par. 0098; the “Buddy search” is transmitted to the server 1); and verifying which users of the first set are registered to the service (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goto et al. to Mathis so that user can user or player can invite another user or player to attend the chat room or play game each other.

Regarding claims 2 and 4, Goto et al. also teach wherein the users that are registered to the service form a second set of users and the server comprises verification means for determining which users in the first set are also in the second set (see pars. 0098-0103); wherein the user interface is arranged to present to the user of the user terminal a farther command option for selecting which of the users of the first set that are registered to the service to subscribe to (see pars. 0098-0103).

Regarding claim 3, Goto et al. also teach wherein the server sends a result message to the user terminal, the result message comprising the identities of the users of the first set that are registered to the service (see par. 0098).

Regarding claim 5, Mathis also teaches wherein each user terminal is a client terminal and the communication system operates in a client-server mode (see par. 0019).

Regarding claim 6, Goto et al. also shows wherein the client terminal is arranged to communicate with the server using a fixed line network (see fig. 1).

Regarding claim 7, Goto et al. also shows wherein the client terminal is arranged to communicate with the server using a wireless communication network (see fig. 1).

Regarding claims 9-10, Mathis also teaches wherein the server is a wireless village server and the service element provides a presence service (see par. 0019); wherein the presence service can provide information indicative of at least one of the following attributes: terminal availability, user status, user location, user moods and user interests (see par. 0019).

Regarding claim 11, Goto et al. also shows wherein the server is connected to a gateway server arranged to operate in a server-server mode (see fig. 1).

Regarding claim 12, Goto et al. also shows wherein each of the user identities is indicated by at least one of: a wireless village identifier, name, telephone number, IP address and email address (see par. 0103).

Regarding claim 14, Mathis also shows a second user terminal which communicates with the user terminal via the server (see fig. 1).

Regarding claims 15-16, Mathis also teaches wherein the server is capable of transferring substantially instant messaging between the user terminal and the second user terminal (see pars.

0010-0012); wherein both of the user terminals are capable of sending presence data representing the status of their respective users to the server in an asynchronous manner, and the server is arranged to, on receiving that data, store that data, and subsequently, in response to the receiving a request from at least one of the user terminals for the presence data of the other user terminal, to transmit the stored presence data of the said other terminal in a substantially instant manner to the said one of the user terminals (see pars. 0010-0012 and par. 0019).

Regarding claim 20, Goto et al. also teach means for receiving from the server a result message indicating the identities of the other users that are also registered to the server (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2).

Regarding claim 25, Goto et al. also teach receiving a result message indicating the identities of other users that are registered to the server (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2).

Regarding claim 29-30, Mathis also teaches determining which users in the first set are also in a second set, the second set comprising users that are registered to the service (see pars. 0018-0019). Goto et al. also teach sending a result message to the user terminal, the result message comprising the identities of the users of the first set that are registered to the service (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2).

Regarding claim 38, Goto et al. also teach subsequent to determining which users in the first set are registered to the service, performing of a further step of sending a result message to the user terminal, the result message comprising the identities of the users of the

first set that are registered to the service (see par. 0098; the data for the buddy search is transmitted to and displayed on the cellular phone 2).

2. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis (US 2003/0083046 A1) in view of Goto et al. (US 2002/0160824 A1) and further in view of Bedingfield, Sr. et al. (US 7,315,614 B2).

Regarding claim 13, Mathis (US 2003/0083046 A1) and Goto et al. do not mention wherein each user identity having a plurality of telephone numbers associated therewith. Bedingfield, Sr. et al. teach each user identity having a plurality of telephone numbers (see col. 1, line 60 to col. 2, line 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Bedingfield, Sr. et al. to Mathis so that user can maintain constant communication.

***Allowable Subject Matter***

3. Claims 8, 18, 21-23, 26-27, 31-33, 36 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 8, Goto et al. and Mathis do not mention wherein the client terminal is arranged to communicate with the server using at least one of a Client-Sever Protocol (CSP) and a Command Line Protocol (CLP).

Regarding claim 18, Goto et al. and Mathis do not mention generating a third set of users of the communications network which are the users of the first set that are registered to the service; sending said third set of users to the user terminal; presenting a second command option

via the user interface for allowing the user of the user terminal to select from said third set which of the registered users to subscribe to receive presence information on, as specified in the claim.

Regarding claims 21-23, Goto et al. and Mathis do not mention wherein the user interface is arranged to present a second command option enabling the user to mark one or more of the user identities received in the result message and a third command option for automatically subscribing to said marked users, as specified in the claims.

Regarding claims 26-27, Goto et al. and Mathis do not mention presenting to the user a second command option enabling the user to mark one or more of the user identities received in the result message; and presenting a third command option for automatically subscribing to said marked users, as specified in the claims.

Regarding claims 31-33, Goto et al. and Mathis do not mention generating a third set of users of the communications network which are the users of the first set that are registered to the service, sending said third set of users to the user terminal for allowing the user of the user terminal to select from said third set which of the registered users to subscribe to; receiving a subscription from the user terminal; and sending presence information based on the subscription, as specified in the claims.

Regarding claim 36, Goto et al. and Mathis do not mention subsequent to reception of a result message indicating the identities of other users that are registered to the server, performing of further steps of: presenting to the user a second command option enabling the user to mark one or more of the user identities received in the result message; and presenting a third command option for automatically subscribing to said marked users, as specified in the claim.

Regarding claim 39, Goto et al. and Mathis do not mention determining which

users in the first set are registered to the service, performing of further steps of generating a further set of users of the communications network which are the users of the first set that are registered to the service; sending said further set of users to the user terminal for allowing the user of the user terminal to select from said third set which of the registered users to subscribe to; receiving a subscription from the user terminal; and sending presence information based on the subscription, as specified in the claim.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Q. NGUYEN whose telephone number is (571)272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis G. West can be reached on (571)272-7859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Q Nguyen/  
Primary Examiner, Art Unit 2617



